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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/099,977      | 03/19/2002  | Francis Emmerson     | 042933/308282       | 5510             |

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| EXAMINER |
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BAYERL, RAYMOND J

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| ART UNIT | PAPER NUMBER |
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2173

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/099,977             | EMMERSON ET AL.     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Raymond J. Bayerl      | 2173                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 13 - 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13 - 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/20/06</u> | 6) <input type="checkbox"/> Other: _____  |

1. Claim 24 is objected to because of the following informalities: Please note the apparent typo "comp rises" in the 20 January 2006 copy. Appropriate correction is required.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 17 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

"A computer program product on a portable radio communication device" in the claim is directed solely to a computer program *per se*, apart from fixation on a tangible machine-readable medium or positively executed upon a computing device. Such a claim does not meet any of the four statutory classes; process, machine, manufacture, composition of matter, since it is instead a non-executed data embodiment with only potential use.

4. Claims 13 – 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roke Manor Research Limited ("Roke Manor"; GB #2 349 548 A) in view of Red Fig Limited ("Red Fig"; GB #2 344 491 A).

As per independent claim 13, directed to a "client-server system" (see also independent claim 14), Roke Manor's Downloading software to mobile telecommunication users discloses a "client terminal" in the form of a "portable radio communication device" and "authentication means" comprising "means for checking validation data of content downloaded from the server". As seen in fig 1, network subscribers 16 using a variety of mobile communication devices such as mobile phone

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or PDAs are permitted to contact a network operator 12 via a base station (see page 4, paragraphs 1, 2), so that software is sent to the subscriber site. Then, “content downloaded from the server” is subject to “validation” by “checking”, by means of an authentication code which enables the Java™ class software to run. In receiving this authentication code, the Roke Manor “device” receives “validation data being associated with said content so as to be identifiable by said authentication means as originating from the said server”, since only the correct “server” for Roke Manor’s software would have the correct authentication code. By this data, the client knows that it is dealing with the actual and proprietary network operator, and not some entity that might have produced a retransmission of the code *per se* for the software.

Roke Manor further teaches the use of “menu applications” that provide “a user selectable direct download link”, in the form of a list that may appear in a menu type format (page 5, paragraph 3). Such a list will invariably appear as “a sub-menu” in the overall “menu” hierarchy of the mobile communication device. Once the Roke Manor subscriber 16 has made a selection, it is properly enabled by the authentication code, which permits the “client terminal” to know that the “user” is properly established in accepting and running the software that has been “downloaded” as “content” from the “server”.

Roke Manor, while identically disclosing the use of a Java™ platform for retrieved software, does not **explicitly** teach that a “browser application controls the radio communication device to transmit a signal to connect to the server”. However, Red Fig specifically discloses Browsing the Internet using a mobile telephone, so as to

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obtain Variable data for HTML pages, accessed via a URL (Abstract). A server process 30 in Red Fig (see pages 7 – 8; fig 2) responds to the URL. HTML pages are an example of “content” that may be directly “downloaded from the server” in Red Fig.

Thus, it would have been obvious to a person having ordinary skill in the art at the time of applicant’s invention to operate the user-selectable interface for software retrieval found in Roke Manor via Red Fig’s “browser”, so that the standard formats of both HTML and Java would have a well-understood channel by which to pass, in obtaining “content” at a “radio communication”-linked site.

When Roke Manor has acquired, authenticated, and installed the software obtained by a subscriber, “storing the downloaded content to a memory of the terminal” takes place, as “default” (claims 15, 21).

In the combination of Roke Manor and Red Fig, a “download transport protocol” of “HTTP” is used (as in Red Fig), and Roke Manor’s use of an authentication code reads upon the claimed “header” (claims 16, 22 - 24), since in an HTTP environment such as Red Fig’s, the code for a page has the authentication information incorporated into it in a way that it leads other portions of the page and is a “header”.

Independent claim 17 (see also independent claim 19) contains limitations generally found in independent claims 13, 14 as noted above, including “menu applications” and “a user selectable direct download link” (Roke Manor), along with a “browser application” that “controls the radio communication device to transmit a signal to connect to the server” (Red Fig).

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Independent claim 18 is rejected for a similar line of reasoning to that developed for claim 17, with its “security checking” further reading upon Roke Manor’s authentication code. This ability to “determine whether or not the downloaded content is from a trusted server” (independent claim 20) has been treated with respect to claim 13 above—in authenticating at the receiving end the user’s entitlement to operate the software, Roke Manor is also allowing the “client terminal” to verify that the sender is indeed the one intended; that of the network operator.

5. Applicant's arguments filed 20 January 2006 have been fully considered but they are not persuasive.

At page 7, applicant argues that in Roke Manor, “the response to a user selection of a service is not to connect to the server”, but instead, “the response of the device is to listen for the relevant Java class to be broadcast”. But it remains true that a request to connect to the broadcasting source is present in the Roke Manor user indicating that such a reception of server content is to take place. This will require, at some point in the communications overall, that “the radio communication device” “transmit a signal to connect to the server” that is providing the Roke Manor broadcast.

At pages 7 – 8, applicant goes on to argue that “neither the Roke Manor reference nor the Red Fig reference teaches or even suggests an authentication or validation process of the type specifically required by [the] claims”, since “the authentication code being provided to the electronic device” in Roke Manor “is only used to enable the software that the server itself provided. It is not used to authenticate the server as a trusted server.” Supposedly, a “malicious programmer” (and not a

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"trusted" one) could "create his 'own' authentication code to be transmitted along with his malicious software.", and the "user downloading this software should have no problem inherently 'trusting' this software because he received the 'correct' code".

However, because the user has received "validation data" from the network operator in Roke Manor, that user has data beyond the software broadcast, and specifically, from that authority which is "identifiable" as the one imparting legitimate use. This is sufficient to read upon the claims, where the particular kind of identification is not recited. The Examiner is not permitted to "read in" what applicant requests to such a phrase, or "a trusted server" as in claim 20, since a form of trust exists between the user in Roke Manor and whatever authority would provide the authentication code for downloaded software. RB

Applicant finally argues at page 9 that "the validation process that occurs in [the] claims" "is entirely different from the 'authentication' process described in the Roke Manor reference", since in Roke Manor, "the authentication code...is used to grant content access to the client device", while in the present invention, "the validation process...is to validate the server." However, it remains that the authentication code in Roke Manor will identify the sending server as that one that is granting access to the downloaded software. In its capacity to be recognized as authenticating, it is also indicative of a proper server that can in fact grant such access.

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6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

In conducting an update search, the Examiner noted that Chan (US #6,760,759 B1) teaches the implementation of Reliability of information pages that are received in mobile communication.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Bayerl whose telephone number is (571) 272-4045. The examiner can normally be reached on M - Th from 9:00 AM to 4:00 PM ET.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (571) 272-4048. All patent application related correspondence transmitted by FAX **must be directed** to the central FAX number (571) 273-8300.

9. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

  
RAYMOND J. BAYERL  
PRIMARY EXAMINER  
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16 March 2006